

(13) and a gripping portion (32), and that the flashlight is kept by frictional force by deflection of the attachment portion.

Birdwell indeed includes an attachment portion (13) and a gripping portion (32), which components are clearly illustrated in Fig. 3. The gripping portions or “arms 32” (col. 4, line 12) in Birdwell extend horizontally along the axis of the apparatus with respect to the flashlight when the apparatus is in a stowed position, as shown in Fig. 1. When the apparatus is in use, the gripping portions, or “arms 32,” extend at some angle with respect to the flashlight. Use of the Birdwell apparatus also requires a mounting mechanism 36 (col. 3, line 66; see also claim 1, col. 6, line 37). The mounting mechanism acts as a removable base when the Birdwell apparatus is in use. Cumulatively, these required components significantly change the profile of the flashlight when the Birdwell apparatus is attached to the flashlight, whether the apparatus is in its stowed or deployed positions.

Applicant’s apparatus does not significantly change the profile of a tool’s handle when the apparatus is attached thereto, whether the apparatus is in its stowed or deployed positions (see specification, page 8, lines 11-16). This characteristic of Applicant’s apparatus is described in independent claim 1, and in independent claim 20. The third element of independent claim 1 reads “the attachment member and grip sharing an outer surface substantially uniformly spaced from the outer surface of the tool.” Also, the second element of independent claim 20 reads in pertinent part “the grip extending away from a first end of the tool in a deployed position and between a second end and the first end of the tool in a stowed position.”

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of independent claims 1 and 20 based on Birdwell, and thereby allows claims 1 and 20, and the appropriate dependent claims.

Rejection Under 35 U.S.C. §103

The Examiner rejected claims 9, 10 and 28 under 35 U.S.C. §103(a) as being unpatentable over Birdwell in view of Praticca et al. (U.S. Patent No. 5,580,157). In particular, the Examiner notes that Praticca et al. shows another flashlight holder comprising a cylinder portion for receiving the flashlight.

It has already been shown that Birdwell's apparatus significantly changes the profile of the flashlight when the Birdwell apparatus is attached thereto. Praticca's apparatus also significantly changes the profile of the flashlight when the Praticca apparatus is attached thereto, as shown in Fig. 1.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Independent claim 28 combines limitations included in independent claims 1 and 20, discussed above. Claim 9 depends from claim 1, and claim 10 depends from claim 9. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claims 9, 10 and 28 over Birdwell in view of Praticca.

ALLOWABLE SUBJECT MATTER

Applicant appreciates the Examiner's determination that claims 29 and 30 are allowable, and that claims 7, 8, 18, 23 and 27 contain allowable subject matter.

CONCLUSION

For the reasons stated above, Applicant earnestly believes that the present application is now in condition for allowance and such action is respectfully requested. Should the Examiner have any further issues remaining, or require further clarification, the Examiner is invited to contact the undersigned at the telephone number appearing below.

Respectfully Submitted,

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